



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/724,379	11/28/2003	Thomas Dietz	17127	9652

7590 12/22/2005

Leopold Presser
Scully, Scott, Murphy & presser
400 Garden City Plaza
Garden City, NY 11530

EXAMINER

KUGEL, TIMOTHY J

ART UNIT	PAPER NUMBER
----------	--------------

1712

DATE MAILED: 12/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

4

Office Action Summary	Application No. 10/724,379	Applicant(s) DIETZ, THOMAS	
	Examiner Timothy J. Kugel	Art Unit 1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☒ Claim(s) 7 and 8 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/28/03</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

1. Claims 1-19 pending as filed on 28 November 2003.

Priority

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Specification

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: Water-based emulsifier wax gels comprising sphingolipids and oil-in-water emulsions comprising the same.

4. The disclosure is objected to because of the following informalities:

The term 'C_{12/18}' should be 'C₁₂-C₁₈' (¶0013).

The term 'C_{6/22}' should be 'C₆-C₂₂' (¶0013).

The acronym 'CTFA' should be defined, at least at its first appearance (¶0017).

The acronym 'CTFA' was construed to stand for Cosmetic, Toiletry and Fragrance Association.

The term 'C_{12/18}' should be 'C₁₂-C₁₈' (¶0017).

The disclosure ends with a partial sentence (¶0045).

Appropriate correction is required.

Claim Objections

5. Claims 7 and 8 are objected to because of the following informalities:

Claim 7 has a double period.

In claim 8, the term 'C_{12/18}' should be 'C₁₂-C₁₈'.

Also in claim 8, the acronym 'PEG' should be 'poly(ethylene glycol)'.

Also in claim 8, the term 'C_{6/22}' should be 'C₆-C₂₂'.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 8, it is unclear what the limitation "addition products of from 2 to 60 mol, in particular 2 to 15 mol or 15 to 60 mol, of ethylene oxide onto castor oil and/or hydrogenated castor oil; polyols or esters; partial esters based on linear, branched, unsaturated or saturated C_{6/22}-fatty acids, ricinoleic acid, and 12-hydroxystearic acid and glycerol, polyglycerol, pentaerythritol, dipentaerythritol, sugar alcohols, alkyl glucosides and polyglucosides" means.

For the purpose of examination, the limitation was construed as:

"a component selected from the group consisting of:

- addition products of from 2 to 60 mol, in particular 2 to 15 mol or 15 to 60 mol, of ethylene oxide onto castor oil and/or hydrogenated castor oil;
- polyols or esters;

Art Unit: 1712

- partial esters based on linear, branched, unsaturated or saturated C₆-C₂₂ fatty acids, ricinoleic acid and 12-hydroxystearic acid
- glycerol;
- polyglycerol;
- pentaerythritol;
- dipentaerythritol;
- sugar alcohols;
- alkyl glucosides; and
- polyglucosides"

Claim Interpretation

8. Claim 8 has been interpreted to require the emulsifier to comprise each of 10 components (a – j):

- a. addition products of from 2 to 30 mol of ethylene oxide and/or 0 to 5 mol of propylene oxide onto linear fatty alcohols having 8 to 22 carbon atoms, fatty acids having 12 to 22 carbon atoms or alkyl phenols having 8 to 15 carbon atoms in the alkyl group;
- b. a component selected from the group consisting of C₁₂-C₁₈ fatty acid mono- and diesters of addition products of from 1 to 30 mol of ethylene oxide into glycerol;
- c. a component selected from the group consisting of glycerol mono- and diesters, and sorbitan mono- and diesters of saturated and unsaturated fatty acids having 6 to 22 carbon atoms and ethylene oxide addition products thereof;

Art Unit: 1712

- d. a component selected from the group consisting of alkyl mono- and oligoglycosides having 8 to 22 carbon atoms and ethoxylated analogs thereof;
- e. a component selected from the group consisting of:
 - addition products of from 2 to 60 mol, in particular 2 to 15 mol or 15 to 60 mol, of ethylene oxide onto castor oil and/or hydrogenated castor oil;
 - polyols or esters;
 - partial esters based on linear, branched, unsaturated or saturated C₆-C₂₂ fatty acids, ricinoleic acid and 12-hydroxystearic acid
 - glycerol;
 - polyglycerol;
 - pentaerythritol;
 - dipentaerythritol;
 - sugar alcohols;
 - alkyl glucosides; and
 - polyglucosides
- f. a component selected from the group consisting of mono-, di- and trialkyl phosphates and mono-, di- and/or tri-poly(ethylene oxide) alkyl phosphates;
- g. wood wax alcohols
- h. a component selected from the group consisting of polysiloxane-polyether copolymers and derivatives thereof

Art Unit: 1712

- i. mixed esters of pentaerythritol, fatty acids, citric acid and fatty alcohol and/or mixed esters of fatty acids having 6 to 22 carbon atoms, methylglucose and polyols; and
- j. polyalkylene glycols.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-7 and 9-19 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent Application Publication 2002/0010215 (Shiroyama hereinafter).

Shiroyama teaches an aqueous ceramide composition (Abstract, ¶0001) comprising 1.0 to 5.0% by weight (Abstract, ¶0012) of a ceramide—including phytosphingosine (¶0004)—that are recovered from mammalian tissues (¶0030), 20:1 to 1:3 of the ceramide—which calculates to 0.05 to 15% by weight—of an nonionic or anionic surfactant (¶0046)—including polyoxyethylene sorbitan fatty acid esters, polyoxyethylene sorbitol fatty acid esters, polyoxyethylene glycerol fatty acid esters, polyoxyethylene fatty acid esters, polyoxyethylene (hydrogenated) castor oil derivatives and sucrose fatty acid esters and mixtures of two or more suitable surfactants (¶¶0042-0043), 0.5 to 2% of a fatty alcohol such as cholesterol (¶¶0048 and Example 5 Table 1 and Comparative Example 2 Table 2), 70 to 88% by weight of water (Examples 1-5 Table 1) and auxiliary components such as humectants (¶0056).

Art Unit: 1712

Shiroyama further teaches a process for preparing the above compositions comprising heating the components except the water to 80 to 120° C and adding to the water, mixing uniformly and cooling to 5 to 40° C (¶0060), and an oil-in-water emulsion comprising the above composition at 5-25% by weight (Examples 9-18 ¶¶0067-0076 and Tables 4-5).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claim 8 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Shiroyama in view of US Patent 6,362,142 (Weber hereinafter).

Shiroyama teaches an aqueous ceramide composition comprising a ceramide, a nonionic or anionic surfactant including mixtures of two or more suitable surfactants a fatty alcohol weight and auxiliary components as described above.

Shiroyama does not disclose expressly the multi-component surfactant as claimed.

Weber discloses a composition for cleaning human skin or hair (Abstract) comprising water (Examples 1-8 and C1-C3 Table 1) cerimides and waxes (Column 10 Lines 32-56) and emulsifiers including nonionic surfactants from at least one of the following groups: (1) products of the addition of 2 to 30 moles of ethylene oxide and/or 0 to 5 moles of propylene oxide onto linear fatty alcohols containing 8 to 22 carbon atoms,

Art Unit: 1712

onto fatty acids containing 12 to 22 carbon atoms and onto alkylphenols containing 8 to 15 carbon atoms in the alkyl group; (2) C₁₂-C₁₈ fatty acid monoesters and diesters of products of the addition of 1 to 30 moles of ethylene oxide onto glycerol; (3) glycerol monoesters and diesters and sorbitan monoesters and diesters of saturated and unsaturated fatty acids containing 6 to 22 carbon atoms and ethylene oxide adducts thereof; (4) adducts of 15 to 60 moles of ethylene oxide with castor oil and/or hydrogenated castor oil; (5) polyol esters and, in particular, polyglycerol esters such as, for example, polyglycerol polyricinoleate or polyglycerol poly-12-hydroxystearate; (6) products of the addition of 2 to 15 moles of ethylene oxide with castor oil and/or hydrogenated castor oil; (7) partial esters based on linear, branched, unsaturated or saturated C₆-C₂₂ fatty acids, ricinoleic acid and 12-hydroxystearic acid and glycerol, polyglycerol, pentaerythritol, dipentaerythritol, sugar alcohols (for example sorbitol), alkyl glucosides (for example methyl glucoside, butyl glucoside, lauryl glucoside) and polyglucosides (for example cellulose); (8) trialkyl phosphates and mono-, di- and/or tri-PEG-alkyl phosphates; (9) wool wax alcohols; (10) polysiloxane/polyalkyl polyether copolymers and corresponding derivatives; (11) mixed esters of pentaerythritol, fatty acids, citric acid and fatty alcohol according to DE-PS 1165574 and/or mixed esters of fatty acids containing 6 to 22 carbon atoms, methyl glucose and polyols, preferably glycerol, and (12) polyalkylene glycols (Column 8 Line 45 – Column 9 Line 21).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include the emulsifier mixture of Weber in the composition of

Shiroyama. The motivation to do so would have been to make the composition suitable for cosmetic preparations (Weber Column 8 Line 45).

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US 6,015,574

01-2000

Cannell et al.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy J. Kugel whose telephone number is (571) 272-1460. The examiner can normally be reached Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

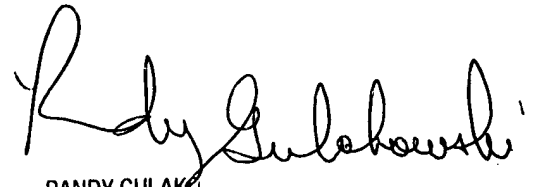
Application/Control Number: 10/724,379

Page 10

Art Unit: 1712

TJK

Art Unit 1712

A handwritten signature in black ink, appearing to read "Randy Gulakov". The signature is fluid and cursive, with a large initial "R" and a long, sweeping underline.

RANDY GULAKOV
SUPERVISORY PATENT
TECHNOLOGY CENTER